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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,663

09/29/2003

Kevin J. Foreman

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26643

7590

09/07/2006

EXAMINER

HUYNH, BA

PETER J. GORDON, PATENT COUNSEL  
AVID TECHNOLOGY, INC.  
ONE PARK WEST  
TEWKSBURY, MA 01876

ART UNIT

PAPER NUMBER

2179

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/673,663	<b>Applicant(s)</b> FOREMAN ET AL.	
	<b>Examiner</b> Ba Huynh	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,628,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broaden scopes of the pending claims 1-19 are read on by the patented claims 1-27.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #5,682,326 (Klingler).

- As for claim 1: Klingler et al (hereinafter Klingler) teach a computer program product, comprising: a computer readable medium storing computer program instructions that, when processed by a computer, instruct the computer to perform a process for facilitating editing of a motion picture (see abstract), comprising: automatically generating in the computer system a sequence of clips representing the motion picture from a description of the motion picture (6:38-67), wherein each clip has an initial duration defined by the description of the motion picture (6:61-62, figure 4); receiving input from a user indicating instructions to associate motion video information stored in computer data files with clips in the automatically generated representation of the motion picture, and storing for each clip a reference to the associated data file and a time range of the motion video information from the associated data file (7:37-59); and updating the duration of each clip to which motion video information is associated to correspond to the duration of the motion video information from the time range (7:55-59).
- As for claim 2. The receiving input comprises: receiving input from the user to select a clip; and receiving input from the user to specify motion video information to be associated with the selected clip (motion video information associated with a selected clip can be specified by an edit command, 7:47-51, 8:1-18, 9:19-29).

- As for claim 4: The receiving input comprises: receiving input from the user to select a clip; receiving input from the user instructing the computer to capture motion video information into a data file on the computer while the selected clip is selected; and associating the captured data file with the selected clip (each clip has a pointer to the physical location where motion video information associated with the clip can be captured into the sequencer data file).
- As for claim 6: The description of the motion picture includes a plurality of shot descriptions (figure 4, "Name").
- As for claim 7: The shot description includes a field for storing a reference to a single still image descriptive of the shot (fig 13).
- As for claim 8: The shot description includes a field for storing in and out points identifying the shot.
- As for claims 9, 10: The shot description includes a field for storing text providing a tip for filming a shot during production (fig 4, "Comment").

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klingler, in view of US patent 5,959,697 (Coleman, Jr).

- As for claims 3, 5: Klingler is silent regarding a clip that has no motion video information associated. However, implementation of the clip with no video information associated (blank clip) is disclosed by Coleman (6:9-18). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Coleman's teaching of the blank clip to Klingler. Motivation of the combine is for online editing as suggested by Coleman. In light of the combining the clip with no motion video information associated will be displayed to the user.
- As for claims 11, 13, 15: Klingler et al (hereinafter Klingler) teach a computer program product, comprising: a computer readable medium storing computer program instructions that, when processed by a computer, instruct the computer to perform a process for facilitating editing of a motion picture, comprising: storing in a computer system a representation of a plan for the motion picture, wherein the plan specifies a sequence of shots, wherein each shot is specified by a shot description including a reference to a textual description of the shot and a duration of the shot (figure 4), displaying to a user a storyboard on a display for the computer system according to the sequence of shots specified by the plan; allowing the user to modify the representation of the plan in the computer system; automatically generating in the computer system a sequence of clips representing the motion picture from the stored representation of the plan, wherein each clip corresponds to a shot in the sequence of shots and has a duration that corresponds at least initially to the duration of the corresponding shot (figure 5); storing motion video information from the sources in data files on the computer system; associating motion video information stored in the data files on the computer system with

each clip in the representation of the motion picture and storing for each clip a reference to the associated data file and a range within the data file, such that the duration of each clip corresponds to the associated motion video information; displaying to the user the sequence of clips as a timeline and in a video window on a display for the computer system according using the associated motion video information (2:3-21); and allowing the user to modify the sequence of clips in the computer system (see description of figure 5). Klingler is silent regarding a clip that has no motion video information associated. However, implementation of the clip with no video information associated (blank clip) is disclosed by Coleman (6:9-18). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Coleman's teaching of the blank clip to Klingler. Motivation of the combine is for online editing as suggested by Coleman. In light of the combining the clip with no motion video information associated will be displayed to the user.

- As for claim 12. The associating motion video information stored in the data files on the computer system with each clip comprises: receiving input from the user to select a clip; and receiving input from the user to specify motion video information to be associated with the selected clip (motion video information associated with a selected clip can be specified by an edit command, 7:47-51, 8:1-18, 9:19-29).
- As for claim 14: The associating motion video information stored in the data files on the computer system with each clip comprises: receiving input from the user to select a clip; receiving input from the user instructing the computer to capture motion video information into a data file on the computer while the selected clip is selected; and

Art Unit: 2179

associating the captured data file with the selected clip (each clip has a pointer to the physical location where motion video information associated with the clip can be captured into the sequencer data file).

- As for claim 16: The shot description includes a field for storing a reference to a single still image descriptive of the shot (figure 13).
- As for claim 17: The shot description includes a field for storing a number identifying the shot (in and out points).
- As for claim 18: The shot description includes a field for storing text providing a tip for filming a shot during production (figure 4, "comment").
- As for claim 19: The shot description includes a field for storing text providing a tip for editing a shot in the motion picture (fig. 4, "comment").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

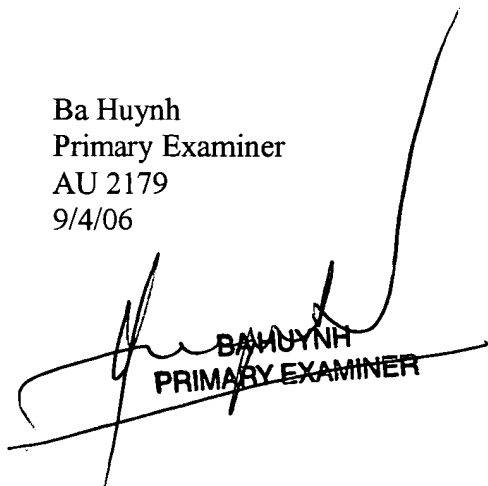
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ba Huynh  
Primary Examiner  
AU 2179  
9/4/06

  
BA HUYNH  
PRIMARY EXAMINER